Practitioner's Docket No. ____944-001.038-1____   **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jose COSTA REQUENA

Application No.: 10 / 023,456	Group No.: 2154
Filed: October 30, 2001	Examiner: Mohammad SIDDIQI
For:	Reexamination control No.:

SYSTEM AND METHODS FOR USING AN APPLICATION LAYER CONTROL PROTOCOL TRANSPORTING SPATIAL LOCATION INFORMATION PERTAINING TO DEVICES CONNECTED TO WIRED AND WIRELESS
Mail Stop Appeal Brief—Patents   INTERNET PROTOCOL NETWORKS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION OR EX PARTE REEXAMINATION—
37 C.F.R. § 41.37)

> NOTE: The phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) (which provides an adjustment of patent term if there is a delay on the part of the Office to respond within 4 months after an "appeal was taken") means the date on which an appeal brief under § 1.192 (and not a notice of appeal) was filed. Compliance with § 41.37 requires that: 1. the appeal brief fee (§ 41.20(b)(2)) be paid (§ 41.37(a)(2)); and 2. the appeal brief complies with §§ 41.73(c)(i)-(x). See Notice of September 18, 2000, 65 Fed. Reg. 56366, 56385-56387 (Comment 38).

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on __October 12, 2007__.

> NOTE: Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. 37 CFR 41.(a)(1). The brief is no longer required in triplicate. The former alternative time for filing a brief (within the time allowed for reply to the action from which the appeal was taken)

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
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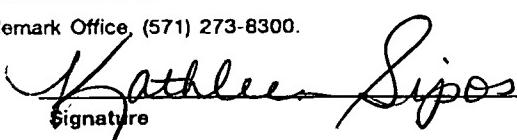
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> * Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Transmittal of Appeal Brief [9-6.1]—page 1 of 5)

2. STATUS OF APPLICANT

This application is on behalf of

ⓧ other than a small entity.

☐ a small entity.

A statement:

☐ is attached.

☐ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ small entity $ 255.00

ⓧ other than a small entity $ 510.00

Appeal Brief fee due $ __510.00__

4. EXTENSION OF TERM

NOTE: 37 C.F.R. § 1.704(b) ". . .an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

NOTE: The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).

NOTE: As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).

☐ The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

WARNING: The provisions of 37 CFR § 1.136 do not apply in an ex parte reexamination. Any requests for extension must be made pursuant to 37 CFR 1.550(c).

(complete (a) or (b), as applicable)

(a) ⓧ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
ⓧ one month	$ 120.00	$ 60.00
☐ two months	$ 460.00	$ 230.00
☐ three months	$1,050.00	$ 525.00
☐ four months	$1,640.00	$ 820.00
☐ five months	$2,230.00	$1,115.00

Fee: $__120.00__

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured, and the fee paid therefor of $ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request $ <u>120.00</u>

or

(b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee $ <u>510.00</u>

Extension fee (if any) $ <u>120.00</u>

TOTAL FEE DUE $ <u>630.00</u>

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AND/OR

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Keith R. Obert

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Attorney Docket No. 944-001.038-1
Serial No. 10/023,456

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Jose COSTA REQUENA   :   Confirmation No.: **2266**

Serial No: **10/023,456**   :   Examiner: **Mohammad SIDDIQI**

Filed: **October 30, 2001**   :   Group Art Unit: **2154**

For: **SYSTEM AND METHODS FOR USING AN APPLICATION LAYER CONTROL PROTOCOL TRANSPORTING SPATIAL LOCATION INFORMATION PERTAINING TO DEVICES CONNECTED TO WIRED AND WIRELESS INTERNET PROTOCOL NETWORKS**

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APPEAL BRIEF

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Kathleen Sipos   Jan. 28, 2008
Kathleen Sipos   Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed October 12, 2007, which was submitted along with a Pre-Appeal Brief Request for Review. The Notice of Panel Decision from Pre-Appeal Brief Review mailed November 28, 2007 indicated that the application remains under appeal. This is an appeal from the final Office Action mailed July 17, 2007 rejecting claims 17-21.

I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is Nokia Corporation, a corporation organized under the laws of Finland.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))

There are no related appeals or interferences.

III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))

Claims 17-21 are rejected to, claims 1-16 and 22-25 have been withdrawn from consideration. The rejection of claims 17-21 is being appealed.

IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

No amendments were filed after the final Office Action of July 17, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

Claim 17 recites a system comprising a central server and a presence server. The central server is for providing a presence query to the presence server in response to an invitation message from an inviting user to exchange content with an invited user who is registered with the presence server. *See* specification page 10, lines 6-9. The presence server is for providing presence information relating to the invited user in response to the presence query. *See* specification. page 10, lines 9-12. The central server uses the presence information in deciding whether the content of the inviting user is sent to the invited user, stored or refused. *See* specification page 10, lines 12-15. The presence query and the invitation message may be communicated according to an application layer control protocol. *See* specification page 10, lines 29-31. The presence information relating to presence may pertain to a spatial location of the invited user registered at the presence server. *See* specification page 11, lines 19-25.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Claims 17 21 are rejected under 35 U.S.C. §103(a) as unpatentable over *Dalal et al.* (U.S. Publ. Appl. No. 2002/0065894) in view of *Armstrong et al.* (U.S. Patent No. 6,807,423).

VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

Rejection Under 35 U.S.C. § 103(a) over U.S. Publ. Appl. 2002/0065894 in view of U.S. Patent No. 6,807,423

Claim 17

In section 3, on page 2 of the Office Action, claims 17-21 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Dalal et al.* (U.S. Publ. Appl. No. 2002/0065894) in view of *Armstrong et al.* (U.S. Patent No. 6,807,423). Appellant respectfully submits that the cited references, alone or in combination, fail to disclose or suggest all of the limitations recited in claim 17. The cited references at least fail to disclose or suggest a central server responsive to presence information relating to an invited user registered at a presence server for use in deciding whether content is <u>sent</u> to the invited user, <u>stored</u> or <u>refused</u>, as recited in claim 17. The Office acknowledges on page 3 of the Office Action that *Dalal* does not disclose deciding whether content is sent to an invited user, stored or refused, and relies upon *Armstrong* for this teaching. However, *Armstrong* also fails to disclose or suggest this limitation recited in claim 17.

Claim 17 is directed to a system with a central server responsive to an invitation message from an inviting user for providing a presence query. Claim 17 further recites that the system also includes a presence server that is responsive to the presence query for providing presence information related to a registered user. The central server is responsive to the presence information from the presence server, and decides based on the presence information whether content is sent to the invited user, stored or refused. However, contrary to the assertions of the Office, *Armstrong* fails to disclose or suggest deciding whether content is sent to an invited user, stored or refused.

Armstrong provides systems and methods of monitoring presence on a multiple access network and communication over the multiple access network. *See Armstrong* column 2, lines 36-39. The instant messaging system discussed in *Armstrong* is capable of spanning multiple communication networks, and provide a party attempting to contact or learn the status of another

party, i.e. a watching party, information about a party who the watching party is attempting to contact or determine the status of, i.e. a watched party. *See Armstrong* column 3, lines 40-45. A watched party specifies preferences as to who may contact the watched party, at what times, on what kind of network and device. A watching party requesting to contact the watched party may be given direct contact information for contacting the watched party without being informed of the watched party's whereabouts, may be placed in direct communication with the watched party, or may forward a message to the user. *Armstrong* discloses that a personal communication portal (PCP) provides a single point of presence despite the fact that a watched party (13) may have more than one terminal and/or different types of terminals for accessing the network in different modes and possibly by different access networks. *See Armstrong* column 4, lines 64-67. Therefore, *Armstrong* provides a way through the PCP (10) to monitor presence of users, but *Armstrong* does not disclose or suggest deciding whether content is sent to an invited user, stored or refused, as recited in claim 17.

In contrast to claim 17, *Armstrong* only discloses that when the personal communications portal (PCP) (10) receives a presence request it determines whether the requested watched party (13) is available for contact, and if the watched party (13) is unavailable the PCP (10) may inform the watching party (12) of this, or connect the watching party (12) to the watched party (13), or give a list of available communication methods. *See Armstrong* column 6, lines 48-61. However, determining whether the watched party (13) is available is not the equivalent of determining how to handle content as recited in claim 17. Claim 17 recites that the central server decides whether to send, store or refuse content based on the presence information, and informing one party as to the availability of another part, as in *Armstrong*, is not deciding how to handle content as recited in claim 17.

In addition, the Office asserts on page 3 of the Office Action, that the PCP (10) determining the best mode of communication corresponds to determining whether to send content to an invited party, as recited in claim 17. However, the PCP merely decides which mode of communication to use based on the watched party's preferences set forth in the rules, and the identity of the watching party. *See Armstrong* column 6, lines 54-58. Deciding upon which mode of communication to use to connect the watching party to the watched party is not the equivalent of deciding whether to send content, since at the time of the presence request no content has been provided by the watching party, and the determination is merely how the

watching party should be connected to the watched party, not how to handle content between the parties.

Furthermore, allowing watching parties (12) to send messages to watched parties (13) even when those watched parties (13) are not available on the communication network is not the same as determining whether content is sent, stored or refused, because no determination is made. *See Armstrong* column 7, lines 20-25. Instead, the forwarding of messages in *Armstrong* occurs based on a watched party's user parameters. In addition, *Armstrong* never discloses that content may be stored as recited in claim 17. In contrast to claim 17, *Armstrong* only discloses that watched party's (13) information and rules may be stored in the PCP (10). *See Armstrong* column 13, lines 45-46. However, the information and rules of the watched party are not content within the meaning of claim 17, because the information and rules are related to the profiles of the watched parties, i.e. how and when the parties may be contacted by watching parties (12). For example, *Armstrong* states that the watched party's profile may contain contact addresses, a set of possible context presence values, and the watched party's own view on what potential audiences its exposed presence has. *See Armstrong* column 13, lines 49-67. It is evident that the information and rules of the watched party included in the watched party's profile is not related to determining how to handle content, but instead is only related to determining how, when and by whom watched parties are to be contacted. Therefore, contrary to the assertions of the Examiner, *Armstrong* also fails to disclose or suggest this limitation recited in claim 17, and the cited references even in combination cannot disclose or suggest claim 17. For at least the reasons discussed above, claim 17 is not disclosed or suggested by the cited references, and appellant respectfully requests reversal of the rejection to claim 17.

Claims 18- 21

Claims 18-21 depend from independent claim 17, and are not disclosed or suggested by the cited references at least in view of their dependencies. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious).

In addition, with respect to claim 18, the filing date of *Dalal* (November 30, 2000) is after the priority date of the present application, November 8, 2000. However, *Dalal* claims priority to provisional application No. 60/168,881 filed December 3, 1999, and therefore is only

available as a reference if the provisional application supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. *See* MPEP § 2136.03. In rejecting claim 18 of the present application, the Office relies upon paragraph [0017] of *Dalal* to teach a central server responsive to notification information for the subscribed user in deciding whether content is sent to the invited user, stored or refused. Presumably, the Office is relying upon the statements that the message and presence formatting and routing entities (23, 24) check the user preference store 26 to determine whether the data should be forwarded. However, this subject matter relied upon by the Office is not supported by the provisional application in a manner that complies with the written description requirement or the enablement requirement of § 112, first paragraph. *See* MPEP § 2161.

The written description requirement of the first paragraph of § 112 requires a disclosure that describes the relied upon subject matter in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the subject matter. *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). The provisional application of *Dalal* makes no mention of determining whether data should be forward or not. Section 2 of Appendix A of the provisional application only mentions that "instant message should be forwarded to the destination device of the user's choice in real time." However, there is no disclosure in the provisional application of *Dalal* that sufficiently describes that a determination is made as to whether or not to forward data, because the provisional application only mentions that messages should be forwarded. Therefore, the subject matter relied upon in rejecting claim 18 at least fails to comply with the written description requirement of § 112, first paragraph.

Furthermore, the enablement requirement of § 112, first paragraph requires a disclosure sufficient to allow one of skill in the relevant art to make and use the invention, and in this case, the subject matter relied upon in rejecting the claims. *See* MPEP § 2164. However, as mentioned above, the provisional application of *Dalal* is completely devoid of any discussion of a UIM processor that is capable of determining whether or not to forward data. Without any direction or suggestion from the provisional application, one of skill in the art would be required to engage in undue experimentation using the discussion of the provisional application to arrive at the subject matter relied upon in *Dalal* to reject the claims. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Therefore, the provisional application of Dalal also fails to comply with the enablement requirement of § 112, first paragraph.

For at least the reasons discussed above, *Dalal* is not available as a reference against claim 18, because its filing date is after the priority date of the present application, and the disclosure of relied upon in rejecting claim 18 is not supported by the provisional application. *See* MPEP § 2136.03 III. Therefore, for at least this additional reason, claim 18 is not disclosed or suggested by the cited references.

Conclusion

For the reasons discussed above, appellant respectfully submits that the rejections of the final Office Action have been shown to be inapplicable, and respectfully requests that the Board reverses the rejections to pending claims 17-21. If any additional fee is required for submission of this Appeal Brief, the Commissioner is hereby authorized to charge Deposit Account No. 23-0442.

Respectfully submitted:

Date: _28 January 2007_

Keith R. Obert
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Registration No. 58,051

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CLAIMS APPENDIX

The claims involved in the appeal are as follows:

17.   System, comprising:

a central server, responsive to an invitation message from an inviting user to exchange content with an invited user, for providing a presence query; and

a presence server, responsive to said presence query, for providing presence information relating to a registered user,

wherein said central server is responsive to said presence information relating to said invited user registered at said presence server, for use in deciding whether said content is sent to said invited user, stored or refused, wherein said presence query and invitation message are communicated according to an application layer control protocol and wherein said presence information relating to said registered user pertains to a spatial location of said registered user.

18.   The system of claim 17, wherein said central server is also responsive to said invitation message for providing a subscription query and wherein said system further comprises a messaging server, responsive to said subscription query, for providing notification information relating to a request from a subscribed user for notification of an event, and wherein said central server is responsive to said notification information for said subscribed user in deciding said content should be sent to said invited user, stored or refused.

19.   The apparatus of claim 18, wherein said application layer control protocol is a session initiation protocol.

20.   The apparatus of claim 19, wherein said presence information pertaining to said spatial

location of said registered user is communicated as a spatial location payload.

21.   The apparatus of claim 17, wherein said presence information pertaining to said spatial

location of said registered user is communicated as a spatial location payload.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.